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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,679	12/19/2000	J. Stuart Cumming	P02087US1	6074

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EXAMINER	
PREBILIC, PAUL B	

ART UNIT	PAPER NUMBER
3738	

DATE MAILED: 08/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/740,679	CUMMING, J. STUART	
	Examiner	Art Unit	
	Paul B. Prebilic	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 April 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *53-102 and 104-124* is/are pending in the application.

4a) Of the above claim(s) *58,60,62,64-76,78-89 and 91-98* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *53-57,59,61,63,73,74,77,90,99-102 and 104-124* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 31 and May 27, 2005 has been entered.

Election/Restrictions

Claims 58, 60, 62, 64-74, 75, 76, 78-89, and 91-98 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 11, 2002.

Terminal Disclaimer

The terminal disclaimer does not comply with 37 CFR 1.321(b) and/or (c) because:

The terminal disclaimer filed on March 31, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of the prior patents has been reviewed and is NOT accepted.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 104 and 106 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of US Patent No. 6,197,059, over claims 1-8 of US Patent No. 5,476,514, and over claims 1-42 of U.S. Patent No. 5,674,282. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the claims of the application and the claims of the patents lies in the fact that the patent claims include more elements and are more specific. Thus, the invention of the patent claims are in effect a "species" of the "generic" invention of the claims of the application. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 1020 (Fed. Cir. 1993). Since the claims of the application are anticipated by claims of the patents, they are not patentably distinct therefrom.

Claims 112, 114, 117, and 119 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-9 of U.S. Patent No. 6,051,024. Although the conflicting claims are not identical, they are not

patentably distinct from each other because the present claims are read on by the patented claims except for the flexible optic. However, flexible optics would have been considered obvious if not inherent to that of the patent claims. For this reason, the Examiner asserts that the present claims are clearly obvious over patented claims.

Claims 112-114, 117, and 121 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending Application No. 10/977,233. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending claims are read on by the present claims such that they are considered to be clearly obvious in view thereof.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 112, 114, 117, 119, 122, and 124 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 32 and 57 of U.S. Patent No. 7,048,760 in view of Hoffer (US 4,244,060) or Tennant (US 5,254,009). The present claims are read on by the patented claims except for the presence of fingers as set forth in the patented claims. However, Hoffer and Tennant both teach that it was known to use finger shaped structures on plate haptics; see the figures of each. Therefore, it is the Examiner's position that it would have been obvious to put fingers on the haptics of the presently claimed device for the same reasons that the prior art does the same.

Claim 53 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/297,233. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claim is read on by the copending claim such that it is considered clearly obvious in view thereof.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 100, 101, 104, 106 and 111 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The terminology "stalk-like" is considered to be indefinite for the same reason that "or like material" was considered indefinite in certain court proceedings; see MPEP 2173.05(b) F that is incorporated herein by reference.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 113 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 113 implicitly suggests that the invention

is in contact with the body such that it implies that the device is connected to a living organism. For this reason, the claim language includes part of a human body within its scope, and thus, it is non-statutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 53-57, 59, 61, 63, 73, 74, 77, 90, 99-102, and 105-124 rejected under 35 U.S.C. 102(b) as being anticipated by Schlegel (US 4,424,597). Schlegel anticipates the claim language where the lens and haptic structure is made entirely out of flexible silicone and it is inherently capable of accommodating due to flexing at the haptics to the extent required by the claim language; see Figures 3 and 4 as well as column 3, lines 17-30 and column 4, line 24 to column 5, line 17. The fact that stiffeners can be added to increase rigidity indicates that the haptics are inherently quite flexible without this optional feature.

With regard to claims 56 and 123, the groove as claimed is between the lens (11) and the ridge (17).

With regard to claim 99, it is noted that the top edge of the upper haptic is about as the lens of optic; see Figure 3.

With regard to claim 100, the stalk-like ridge as claimed is the ridge (17) of Schlegel.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 104 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schlegel (US 4,424,597) in view of Tennant (US 4,254,510) or Tennant (US 5,254,009). Schlegel meets the claim language as explained *supra* but fails to disclose pairs of stalk-like knobs for each haptic as claimed. However, both Tennant ('510; see Figure 1 and elements 13a and 14a) and Tennant ('509; see Figure 1 and elements (26)) teach that pairs of stalk-like knobs for each haptic were known. Therefore, it is the Examiner's position that it would have been obvious to form such features on the Schlegel device for stability of the implanted device and for the same reasons that Tennant ('510 or '509) utilizes the same.

Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 of 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Prebilic
Primary Examiner
Art Unit 3738